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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,677	01/04/2002	Stephen Brian Falder	16644/09003CIP	9699

27530 7590 07/12/2006

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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/039,677	Applicant(s) FALDER ET AL.	
	Examiner Alton N. Pryor	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 18 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1,46,49,52,53,59,61,62,70,71,78,82-85,88-92,95-100,105-134 is/are pending in the application.
- 4a) Of the above claim(s) 49,53,88-91,95-98,100,111,112 and 116-119 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,46-48,52,61,62,70,71,78,82-85,92,99,105-110,113-115,120-134 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

I. Rejection of claims 1,46-48,52,61,62,70,71,78,82-85,92,99,105-110,113-115,120-134 under 35 USC 103(a) as being obvious over Jackson and Dorothy will be maintained in light of amendment filed 4/18/06 for reason on record and reason as follows.

- 1) Applicant argues, claimed invention taken as a whole cannot be considered to be obvious without some reason given in the prior art as to why one of ordinary skill would have been prompted to combine Jackson and Dorothy. Examiner argues that Jackson and Dorothy teach anti-microbial compositions for disinfecting surfaces; therefore, since references disclose the same utility, it is proper to combine them.
- 2) Applicant argues, references cited by Examiner cannot be combined because the combination does not provide any evidence that a person of ordinary skill in the art would have had a sufficient basis for the required expectation of success. Examiner argues, since both references teach anti-microbial compositions for disinfecting surfaces, an artisan would expect for there combination to do the same - this is success.
- 3) Applicant argues, Dorothy teaches that a strong acid is required in the composition to promote adhesion of the composition to surfaces such as glass; a person skilled in the art would not have contemplated adding the polydimethylsiloxane of Dorothy to Jackson, which does not contain a strong acid. Examiner argues, the claims employ comprising language

which allows for the inclusion of additional ingredients such as strong acids.

- 4) Applicant argues, because the example in Dorothy requires the presence of three surfactants in addition to polydimethylsiloxane, an artisan would have had no expectation that a useful composition containing polydimethylsiloxane could be produced not containing three surfactants. Examiner argues, the claims employ comprising language which allows for the inclusion of additional ingredients such as the three surfactants.
- 5) Applicant argues, compositions of the invention not only kill micro-organisms that are present on a surface to which they are applied but also have a residual effect in that they substantially reduce / control formation of microbial colonies on or at the surface to which they have been applied; in other words, instant compositions have a lasting effect. Examiner argues, applicant is arguing subject matter which is not a claim limitation. In addition, since the combination of references result in the instant composition, it is expected that the final composition would exhibit the same utility, i.e., a lasting effect once applied to a surface.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Alton N. Pryor', is written over the printed name.

Alton Pryor
Primary Examiner
AU 1616